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OFFICE OF PETITIONS

In re Application of
James W. Cree et al.
Application No. 09/491,721
Filed: January 27, 2000
Attorney Docket No. 31358-233

ON PETITION

Petitioner claims non receipt of a Final Office Action mailed December 9, 2002. This is a decision on the petition filed September 8, 2003, to revive the above identified application under. This decision also treats the petition under 37 CFR 1.181 to withdraw the holding of abandonment.

The petition under 37 CFR 1.181 is **DISMISSED**.
The petition under 37 CFR 1.137 (a) is **DISMISSED**.

This application became abandoned on March 11, 2003, for failure to file a timely response to the Final Office Action mailed December 9, 2002, which set a three (3) month shortened statutory period for reply. No extensions of the time for reply under 37 CFR 1.136(a) were obtained. Accordingly, a Notice of Abandonment was mailed July 31, 2003.

While petitioner entitles the petition as one to withdraw the holding of abandonment, petitioner argues that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition under 37 CFR 1.137(a) was unavoidable and pays the fee under 37 CFR 1.17(l). This decision will address both arguments.

PETITION TO WITHDRAW THE HOLDING OF ABANDONMENT

Petitioner asserts that the "Notice" mailed on December 9, 2002, was never received. A review of the record indicates no irregularity in the mailing of the "Notice", and in the absence of any irregularity in the mailing, there is a strong presumption that the "Notice" was properly mailed to the address of record. This presumption may be overcome by a showing that the "Notice" was not in fact received. The showing required to establish the failure to receive the "Notice" must include a statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. A copy of the docket record where the non-received Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement.[1] The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the "Notice" may have been lost after receipt rather than a conclusion that the "Notice" was lost in the mail (e.g. if the practitioner has a history of not receiving Office communications).

Petitioner provides docket records from the previous attorney of record however, the rule would require a statement from the attorney of record, empowered with the

[1] MPEP § 711.03(c); See Notice entitled "Withdrawing the Holding of Abandonment When Office Actions Are Not Received," 1156 O.G. 53 (November 16, 1993).

authority to prosecute the application on December 9, 2002, that the Notice was not received. The showing of record therein is insufficient to warrant withdrawal of the holding of abandonment.[2]

PETITION UNDER 37 CFR 1.137(a)[3]

The Commissioner may revive an abandoned application if the delay in responding to the relevant outstanding Office requirement is shown to the satisfaction of the Commissioner to be "unavoidable".[4] Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

> The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.[5]

The showing of record is inadequate to establish unavoidable delay within the meaning of 35 U.S.C. § 133 and 37 CFR 1.137(a).[6] Specifically, an application is "unavoidably" abandoned only where petitioner, or counsel for petitioner, takes all action necessary for a proper response to the outstanding Office action, but through the intervention of

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[2]In order to have a holding of abandonment withdrawn, a petitioner must demonstrate that the Office communication in question was not received at the address to which it was mailed. See Delgar v. Schuyler, 172 USPQ 513 (D.D.C. 1971).

[3]A grantable petition under 37 CFR 1.137(a) must be accompanied by:

(1) the required reply, unless previously filed; In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional utility or plant application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 1.114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

(2) the petition fee as set forth in 37 CFR 1.17(l);

(3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and

(4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c)).

[4]35 U.S.C. § 133.

[5]In re Mattullath, 38 App. D.C. 497, 514-15 (1912)(quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

[6]See MPEP 711(c)(III)(C)(2) for a discussion of the requirements for a showing of unavoidable delay.

unforeseen circumstances, such as failure of mail, telegraph, facsimile, or the negligence of otherwise reliable employees, the response is not timely received in the Office.[7]

Rather than unavoidable delay, the only arguments made are those of not having received the office communication mailed December 9, 2002. Since it hasn't been shown that the office communication mailed December 9, 2002 wasn't in fact received by Jenkens & Gilchrist, P.C. the argument that the delay in filing the required reply was unavoidable also fails.

As petitioner has not provided a showing of evidence to satisfy the requirements of a grantable petition under 37 CFR 1.137(a), the petition will be dismissed.

ALTERNATIVE VENUE

Petitioner may wish to consider filing a renewed petition under 37 CFR 1.137(b), which now provides that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 CFR 1.137(b).

The filing of a petition under the unintentional standard cannot be intentionally delayed and therefore should be filed promptly. A person seeking revival due to unintentional delay cannot make a statement that the delay was unintentional unless the entire delay, including the delay from the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 CFR 1.137(b).

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[7] Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887).